

REMARKS

Applicants have considered the outstanding official action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

Applicants note that claim 125, which had been subject to restriction, has been rejoined. Further, it is noted that withdrawn claims have been amended where applicable to correspond to amendments made in elected claims so that rejoinder of the withdrawn claims may be considered upon allowance of the elected claims.

Claims 63-85 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement based on claim 63 as set forth at page 3 of the official action. Claim 63 has been amended to provide that the first ply is bonded to the third ply and that the second ply is bonded to the third ply. Withdrawal of the §112, first paragraph, rejection is requested.

Claim 125 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement based on the use of the term "alternatively". Claim 125 has been amended to provide that the first areas

and second areas are staggered to one another and that the third ply is bonded at the first areas and the second areas which are staggered with respect to one another. The term "alternatively" indicated that the third ply is bonded to both of the first areas and the second areas, but in different areas, i.e., not in coincident areas. This has been clarified and, thus, withdrawal of the §112 rejection of claim 125 is requested.

Claims 63-85 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite as set forth at pages 4-5 of the official action. As set forth above, claim 63 has been amended to clarify the bonding relationship between the first and third plies and the second and third plies. The phrase "at a level of" has been deleted and replaced with "in areas corresponding to" as used in other claims.

As to claim 75, claim 75 is consistent with claim 63 since claim 63 in the penultimate indented section claims "wherein areas in said second ply corresponding to said areas in the first ply are devoid of any protuberance or have a flattened protuberance". Thus, if decorative protuberances in the first and second plies are superposed, those protuberances of the second ply are flattened in

accordance with claim 63. Thus, applicants submit that claim 75 is definite.

As to claim 76, claim 76 is directed to when the third ply is not embossed prior to bonding with the first and second plies. To move prosecution forward, claim 76 has been canceled, but applicants note that such remains within the scope of claim 63 which uses the open transition term "comprising".

Accordingly, the matters raised under the §112, second paragraph, rejection of claims 63-85 have been addressed. Withdrawal of the §112, second paragraph, rejection is thus requested.

Claim 125 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite based on the term "partly" when used to modify "staggered", and as to the term "alternatively".

As to the term "partly", such has been deleted from claim 125. As to the term "alternatively" such has been deleted from claim 125 and the claim further amended to clarify what is being claimed as set forth above with respect to the rejection of claim 125 under §112, first paragraph. Accordingly, withdrawal of the rejection under §112, second paragraph, is requested.

The outstanding rejections based on art are as follows:

- (1) Claims 63-76 and 82 under 35 U.S.C. §103(a) over U.S. Patent No. 6,287,676 B1 (Ruppel);
- (2) Claims 77-78 under 35 U.S.C. §103(a) over Ruppel in view of U.S. Patent No. 6,221,211 B1 (Hollenberg);
- (3) Claims 79-81 under 35 U.S.C. §103(a) over Ruppel in view of U.S. Patent No. 6,599,614 B1 (Roussel);
- (4) Claim 83 under 35 U.S.C. §103(a) over Ruppel in view of U.S. Patent No. 6,755,928 B1 (Biagiotti);
- (5) Claims 84-85 under 35 U.S.C. §103(a) over Ruppel in view of Roussel; and
- (6) Claim 125 under 35 U.S.C. §103(a) over Ruppel.

Claims 63 and 125 are the sole rejected independent claims. Ruppel is the only reference applied against each of claims 63 and 125 in a rejection under 35 U.S.C. §103(a). The other rejected claims are dependent directly or indirectly on claim 63. These dependent claims are rejected over Ruppel in combination with a secondary reference, i.e., Hollenberg (claims 77-78), or Roussel (claims 79-81 and 84-85) or Biagiotti (claim 83), which are relied on with respect to additional limitations in the

dependent claims. Thus, if Ruppel is overcome, all the rejections are overcome. Applicants respectfully submit that Ruppel does not teach or suggest applicants' claimed web material. Initially it is noted that claim 63 has been amended and claims 66, 67 and 76 have been canceled. Essentially, the subject matter of claims 66 and 67 has been incorporated into claim 63.

Ruppel does not disclose, and the arrangement described in Ruppel does not allow for, first and second glues in different areas on first and second plies to bond the first ply to a third ply with the first glue and the second ply to the third ply with the second glue. The device shown in Fig. 3 of Ruppel only applies glue on one and the same ply and applies pressure on protuberances generated on that ply by the first embossing roller 101. There is no teaching or suggestion in Ruppel that a second glue is or could be applied on protuberances generated on ply 2 by roller 105. There is no teaching in Ruppel that a third ply be fed between the first ply and the second ply and that pressure be applied on:

- a) protuberances of the first ply to adhere the first ply and the third ply together by the first glue; and

b) protuberances of the second ply to adhere the second ply and the third ply together by a second glue.

When the teachings of Ruppel are taken as a whole, there is no teaching and no fair suggestion in Ruppel which would lead one skilled in the art to modify the article of manufacture described in Ruppel which is produced by the method and machine also described therein to include the combination of features as now claimed in claim 63.

With respect to claims 66 and 67, the subject matter now being incorporated into claim 63, applicants note that in the outstanding office action on page 8, last paragraph, the Examiner rejects these claims based on Ruppel stating that two plies (1) and (2) are linked via glue on the top of the bases of the first pattern of one of the sheets and that the tips of the two sheets are coated with glue citing column 1, lines 33-37 of Ruppel, and that a third ply can be interposed between the two plies (1) and (2), which would "intrinsically provide a reciprocal glue adhesion between the three sheets" (original emphasis) as claimed. The passage at column 1, lines 33-37 of Ruppel does not teach using two different glues, one applied on a first ply and the other applied to a second ply in order to adhere the first ply to a third ply and the second ply to

said third ply. Rather, this passage describes placement of glue on projection tips of a first ply so that when the tips are inserted between projections on a second ply, i.e., the first ply nested within the second ply, the tips will adhere to the second ply to hold the first ply to the second ply. Thus, Ruppel does not teach or suggest using first and second glues and, in particular, does not teach a first glue being between a first ply and a third ply and a second glue being between a second ply and the third ply. One skilled in the art would not be motivated by the teachings of Ruppel to modify the article described in Ruppel to obtain the web material as claimed by applicants. One skilled in the art would not have any suggestion on how to modify the teaching of Ruppel to obtain the web material as now claimed in claims 63 and 125.

The structural features of claims 63 and 125 provide a double-face product, i.e., a product which has two sides characterized by entirely different patterns, decorations and tactile properties, which cannot be obtained from the teachings of Ruppel. Thus, the claims are not rendered obvious in view of Ruppel. As set forth above, the secondary references are only relied on for teaching additional limitations present in dependent claims and,

6768/USSN 10/591,392
Group Art Unit 1788

thus, do not make up for the shortcomings of Ruppel.
Withdrawal of the §103 rejections is, therefore, requested,
Reconsideration and allowance of the claims are
respectfully urged.

Respectfully submitted,

GIOVANNI NENCIONI ET AL

By Mary Breiner
Mary J. Breiner, Attorney
Registration No. 33,161
BREINER & BREINER, L.L.C.
P.O. Box 320160
Alexandria, Virginia 22320-0160

Telephone: (703) 684-6885